

McDermott Will & Emery

Boston Brussels Chicago Düsseldorf London Los Angeles Miami Milan
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Cameron K. Weiffenbach
Counsel
cweiffenbach@mwe.com
202.756.8171

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Jon W. Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the U.S. Patent and Trademark Office
Mail Stop OED-Ethics Rules
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

RE: Comments regarding Proposed Changes to the Rules Regulating
Representation of Others Before the United States Patent and Trademark Office
Federal Register, Vol. 72, No. 39, pages 9196-9220 (February 28, 2007)

Dear Sir:

I would like to thank the Office for the opportunity to make comments on the proposed rules referred to above. I am a patent practitioner at the law firm of McDermott Will & Emery in the firm's Washington, DC office. I have the following comments with respect to the proposed rules.

Rule 11.2(c) prohibits the staying of other proceedings when a petition is filed regarding enrollment or recognition. The rule is not clear as to what "other proceedings" mean. If it is a petition challenging an action taken by OED in a proceeding, then the prospective registrant should be given the opportunity to file such a petition and to have it decided before the due date of the proceeding. It is suggested that the rule be amended to allow the Director discretion to stay other proceedings or to stay the proceedings based on good and sufficient reasons presented by the prospective registrant in the petition.

Rule 11.5(b) and its subsections: Rule 11.5(b) says that practice before the Office "includes, but is not limited to" While the proposed rule goes on to define practice in patent cases and trademark cases, the aforesaid language is vague and indefinite since it does not put the public on notice as to what else would constitute patent practice before the Office. The Office needs to define exactly what constitutes the practice of patent law subject to USPTO jurisdiction. The *Sperry* case allows a patent agent or an attorney who is practicing patent law, but who is not licensed to practice in the jurisdiction in which he or she resides to practice patent law under the license granted by the Office. There are facets of patent law that are closely related to the preparation and prosecution of patent applications. Assignments and licenses just two major

U.S. practice conducted through McDermott Will & Emery LLP.

600 Thirteenth Street, N.W. Washington, D.C. 20005-3096 Telephone: 202.756.8000 Facsimile: 202.756.8087 www.mwe.com

